

REMARKS

In response to the Office Action of February 4, 2004, applicant herewith submits Claims 8 and 9 completely underlined in accordance with the provisions of 37 CFR 1.173.

With respect to Claim 8, the recitation of "said ferrule having a downwardly depending flange" has been amended to recite that the flange is seated "in an enlarged portion of the hosel in the club head to resist side loading on the ferrule".

With respect to Claim 9, the recitation that "said ferrule having an integral downwardly depending flange seated in the club head" has been amended to delete the phrase that the downwardly depending flange is seated "in the hosel bore upper portion" and has been amended to add that the downwardly depending flange is seated "in an enlarged portion of the hosel bore in the club head to resist side loading on the ferrule".

It should be noted that Claims 10, 11 and 12 were cancelled in the Amendment of November 24, 2003.

The arguments that Claims 8 and 9 have been improperly rejected on the basis of improper recapture recited in applicant's Amendment of November 24, 2003 are incorporated herein and set forth as follows:

Claims 8 and 9 have been rejected solely on the ground of being an improper recapture of subject matter surrendered in the original application under 35 USC 251, the Examiner stating:

"Claims 8-12 are rejected under 35 USC 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed.Cir.1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed.Cir.1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289,295 (Fed.Cir.1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 USC 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Specifically, as to claim 8, the applicant notes in his reissue declaration that claim 8 corresponds substantially to original patent claim 1 with the deletion of the phrase 'having a top surface that is coplanar with or projects upwardly a short distance from the top wall' while also reciting that the ferrule is mounted 'adjacent the hosel'. Here, the applicant has failed to further recite that the ferrule has a downwardly depending flange seated 'in a groove', as was the case in original claim 1 of the patent. The fact that the groove is an essential part of the claimed invention was vehemently argued on page 4 of the amendment received 11/23/1998 in parent application serial number 08/960,966."

The patent owner's counsel apologizes for the omission of a discussion of the deletion of the limitation of the flange seated in a groove in the hosel on page 4 of the Reissue Declaration and asks that this statement be incorporated by reference into the Reissue Declaration.

With respect to Claim 9, the Examiner states:

"Specifically, as to claim 9, the applicant notes in his reissue declaration that claim 9 corresponds substantially to original patent claim 6 with the cancellation of 'on the hosel top surface' and the substitution therefor with the phrase 'adjacent the hosel'. Here, the applicant has failed to further recite that there exists an annular groove in the club head coaxial with the hosel bore and wherein the ferrule has an integral downwardly depending annular flange seated in the annular groove. Again, the fact that the groove is an essential part of the claimed invention was vehemently argued on page 4 of the amendment received 11/23/1998 in parent application serial number 08/960,966."

At the outset, the claim limitations in both original Claims 9 and 10 that the ferrule flange is seated in "a groove" or an "annular groove" were original claim limitations as filed in Claims 1 to 6 in parent application serial number 08/960,966 filed October 30, 1997, which issued into U.S. Patent No. 5,938,541 on August 17, 1999. That is, they were not added by amendment to overcome prior art in the classic file wrapper estoppel situation.

True, the flange and groove were discussed on page 4 of the parent application, but the patent owner disputes the Examiner's characterization of that page 4 discussion as "the fact that the groove is an essential part of the claimed invention was vehemently argued on page 4 of the amendment."

Instead, the second paragraph on page 4 is simply an identification of the differences between the claims in the parent application serial number 08/960,966 and its own parent application 08/925,301. This is clear from the opening sentence:

"The distinction between the claims in the present case and the claims in the parent application(08/925,301) is that the present claims include "a downwardly depending flange on the ferrule that is seated in a groove in the clubhead".

This is not an argument of either essentialness or patentability and it is improper to apply the recapture estoppel in this situation.

There is nothing essential about the flange fitting in a "groove" in the hosel bore, if the groove is defined as having a sharp bottom shoulder such as identified at the lead line end for reference character 120 in Fig. 14 of the drawings for example. An obviously equivalent structure could include an enlarged hosel bore with the flange

seated in the enlarged hosel bore. Certainly, the Examiner would agree these two designs are equivalent in structure and function.

To emphasize the essential aspects of the flange seating, Claims 8 and 9 has been have been amended to recite that the flange is "seated in an enlarged portion of the hosel".

Hopefully, this will resolve the recapture issue.

The *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed.Cir.1998) and the *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed.Cir.1997) cases cited by the Examiner have totally different fact situations.

The *Hester* Court found (USPQ2d at 1647):

"We share the district court's discomfort with Williams' attempt to remove, through reissue, the 'solely with steam' and 'two sources of steam' limitations after having relied so heavily on those limitations to obtain allowance of the original patent claims over the prior art.

As detailed above, Williams repeatedly argued that the 'solely with steam' and 'two sources of steam' limitations distinguished the original claims from the prior art. These were Williams' primary bases for distinguishing the broadest claim, independent claim 1, from the prior art. At no less than 27 places in six papers submitted to the Patent Office, Williams asserted that the 'solely with steam' limitation distinguished the claimed invention from the prior art, and Williams did the same with respect to the 'two sources of steam' limitation at no less than 15 places in at least five papers.

Williams argued that each of these limitations was 'critical' with regard to patentability, and Williams further stated that the 'solely with steam' limitation was 'very material' in this regard. In essence, these repeated arguments constitute an admission by Williams that these limitations were necessary to overcome the prior art. Indeed, when the Board reversed the Examiner's rejection of the original claims, these were the primary bases indicated for patentability. Williams, through his admission effected by way of his repeated prosecution arguments, surrendered claim scope that does not include these limitations." (USPQ2d at 1649)

Thus, *Hester* can be distinguished because the patentee argued 27 times in 6 different papers the two limitations were critical to his invention and these limitations were expressly relied on by the Board in allowing the claims.

In the *Clement* case, which is even a more outrageous set of facts than the *Hester* case, the patentee sought by reissue to delete some 8 (eight) limitations that were added by amendment in the original application all to define over prior art. The *Clement* patent related to a method of treating waste paper to remove contaminants, such as adhesives, as well as ink particles and included steps (A) forming -- (B) separating -- (C) softening -- (C) detaching -- and (E) removing --. Reissue Claim 49 was more specific than the pre-amended patent Claim in that it included "at least 59 ISO in the final pulp", but was broader in 8 respects in that it eliminated the room temperature

limitation and specific energy limitations in step A; it eliminated the temperature, specific energy, and PH values in step C; and eliminated the temperature, specific energy and PH values in step D.

All of these limitations were added in the original application to overcome prior art.

It is clear that the *Clement* Court was influenced by the fact that the subject matter eliminated was far more material than the subject matter added in Reissue Claim 49. Note the following statement by the Court:

"On balance, reissue claim 49 is broader than it is narrower in a manner directly pertinent to the subject matter that Clement surrendered throughout the prosecution. Even with the additional limitations, claims 50-52 are also broader than they are narrower in a manner directly pertinent to the subject matter that Clement surrendered during prosecution."

On balance, the present Reissue Claim 21 is narrower in five respects than Claim 20 prior to the July 30, 1993 amendments in a manner directly pertinent to the subject matter of the invention.

The *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289,295 (Fed.Cir.1984) case, in which the Court of Appeals in 1984 found that the recapture rule did not apply, related to an invention of a dual slot antenna assembly intended for use on missiles. During the prosecution of the original application, Claims 7, 8 and 9, which were cancelled subsequently, did not include the limitation

of "a plurality of feed lines". The Examiner suggested the allowability of the plurality of feed lines if presented in independent form and following the second Office Action, Ball added that limitation to the claims that were eventually matured into patent claims.

Reissue Claim 5 did not include a plurality of feed lines, and the Government contended that Ball's deliberate cancellation of the single feed line claim was not error, and that that act was taken to avoid a prior art rejection, and in the Government's view, the recapture rule barred Ball from securing similar claims through reissue.

The Court of Appeals for the Federal Circuit stated in discussing the Ball facts:

"The CCPA has repeatedly held that the deliberate cancellation of claims may constitute error, if it occurs without deceptive intent" citing the Wadlinger, 496 F.2d at 1206, 181 USPQ at 831.

The Court then went on to state:

"The Ninth Circuit employed a more rigid standard in Riley v. Broadway-Hale Stores, Inc. stating: 'when the chief element added by reissue has been abandoned while seeking the original patent, the reissue is void.' The trial judge sought to determine whether Ball has made a deliberate judgment that claims of substantially the same scope as the new reissue claims would have been unpatentable. The Government, arguing from Riley, submits that the trial judge's approach loses sight of the feature given up by a patentee in order to secure the original patent. We decline to adopt the rigid standard applied in Riley, in favor of the more liberal approach taken by the CCPA. Petrow clearly es-

tablishes the vitality of the standard employed by the trial judge under this court's precedent."

It is noteworthy that the *Ball* Court, as well as the *Clement* Court, compared the reissue claims to the cancelled claims, rather than the claims as amended, as evidenced by the following statement (noting the above comparison to original Claim 20 without the July 30, 1993 amendments):

"The canceled claims, claims 7 and 8, define the invention quite broadly. Canceled claim 8 requires feed means including at least one conductive lead. The reissue claims, in contrast, include limitations not present in the canceled claims: the cavity is filled with a dielectric material; and an electrical signal feed assembly replaces the feed means of the canceled claims. The electrical signal feed assembly (Fig. 6) is a network of leads with a single coaxial feedline to that network. The network consists of a plurality of thin ribbon-like conductive leads.

Feed points 53 to the outer conductor are one wavelength apart at the anticipated operating frequency of the antenna. The leads of this network 52, 54, 56, 58, are dimensioned to provide continuous impedance matching between the cavity and the single coaxial feedline 70, which feeds into the assembly at the aperture 48. The signal feed assembly is more limited than the 'at least one' feed means limitation of canceled claim 8."

Thus, the reissue claims in *Ball* were, in several respects, as in the present case, more specific than the cancelled Claims 7 and 8. The Court, however, noted that

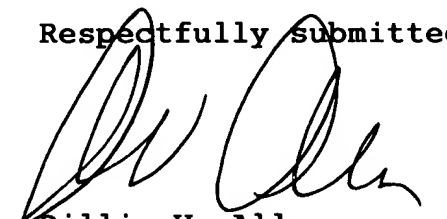
the reissue claims were in fact broader in one respect, with respect to the cancelled claims(which is not the case here), and made the following statement:

"The reissue claims are, however, broader in one respect. The canceled claims are limited to an antenna of cylindrical configuration, whereas the reissue claims are not so limited. We are aware of the principle that a claim that is broader in any respect is considered to be broader than the original claims even though it may be narrower in other respects. That rule will not bar Ball from securing the reissue claims here on appeal."

Thus, in the *Ball* case, the facts are even weaker for no recapture than the present case because in *Ball*, the reissue claims had some five limitations more specific than cancelled claims 7 and 8, but one limitation, the cylindrical antenna configuration, that was broader than the cancelled claims.

For the above reasons, it is respectfully requested that this application be allowed and passed to issue.

Respectfully submitted,



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